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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,871	10/18/2004	Yutake Ueda	04737/LH	6520
1933 7590 05/29/2007 FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708			EXAMINER ALI, OMAR R	
			ART UNIT 2109	PAPER NUMBER
			MAIL DATE 05/29/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/511,871

Applicant(s)

UEDA, YUTAKE

Examiner

Omar Abdul-Ali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/04, 10/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following action is in response to the original filing of October 18, 2004. Claims 1-8 are pending and have been considered below.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 8 is drawn to a computer program per se. A computer program is not a series of steps or acts and this is not a process. A computer program is not a physical article or object and as such is not a machine or manufacture. A computer program is not a combination of substances and therefore not a compilation of matter. Thus, a computer program by itself does not fall within any of the four categories of invention. Therefore, Claim 8 is not statutory.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-3, 5, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kiso et al. (JP 2001-103415).

Claim 1: Kiso discloses a storage medium, comprising:

- a. image information (paragraph 9);
- b. an information outputting program for outputting a computer image based on image information (paragraph 9);
- c. an automatic copying program for automatically saving copy information of the image information and the information outputting program in a specific location of the computer (paragraph 14/paragraph 17).

Claim 2: Kiso discloses a storage medium as in Claim 1 above, further comprising:

- a. the automatic copying program automatically saves a part of the image information and the information outputting program in the computer at the specific location (paragraph 14/paragraph 17).

Claim 3: Kiso discloses a storage medium as in Claim 1 above, further comprising:

- a. the specific location is either an internal disc of the computer, or an internal disc of another computer that is connected to the computer through a network, or a recording medium in which information can be stored by a recording apparatus that can be connected to another computer (paragraph 14).

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Claim 5: Kiso discloses a storage medium as in Claim 1 above, further comprising:

- a. unique identification [created sequence table] (paragraph 14);
- b. automatic copying program acquires information storage area at the specific location corresponding to the identification information and automatically saves the copy information of the information in the information storage area (paragraph 14).

Claim 8: Kiso discloses a computer program to function as an automatically saving section to save at a specific location of the computer the copy information of the image information and the information outputting program that outputs images based on the image information (paragraph 14).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kiso et al. (JP 2001-103415) in view of Matsumoto (JP 2000-200475).

Claim 4: Kiso discloses a storage medium as in Claim 1 above, but does not explicitly disclose music song audio information. Matsumoto discloses a similar recording device that further discloses controlling music audio files (paragraph 52). Therefore, it would

have been obvious to one having ordinary skill in the art at the time the invention was made to include music song audio information in Kiso. One would have been motivated to include music song audio information for design choice.

Kiso does not explicitly disclose the information outputting program to display in a selectable manner the storage location for the music song audio information, and to control a computer to function as a simultaneously outputting section to simultaneous outputting images based on the image information and music song audio based on selected the music song audio information. Matsumoto discloses a similar recording device that further discloses controlling music audio files and images (paragraph 52). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to display in a selectable manner the storage location for music song audio information and simultaneously output images based on information and music song audio information. One would have been motivated to perform this function to allow the user to easily manipulate image information according to each corresponding music song audio information.

Kiso also does not explicitly disclose the automatic copying program to control a computer to function as a saving section to automatically save copy information of the image information, selected the music song audio information, and the information outputting program, in the specific location of the computer. However, Kiso does disclose automatically saving copy information of the image information and the information outputting program (paragraph 14/paragraph 17), and Matsumoto further discloses saving song information (paragraph 88). Therefore, it would have been

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obvious to one having ordinary skill in the art at the time the invention was made to automatically save copy information of image, selected song information, and an information outputting program in Kiso. One would have been motivated to automatically save copy information of each type of data to provide backup copies of the data.

7. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiso et al. (JP 2001-103415).

Claim 6: Kiso discloses a storage medium, comprising:

- a. image information (paragraph 9);
- b. an information outputting program that outputs to the computer images based on the image information (paragraph 9);
- c. an automatic copying program that automatically saves in a specific location of the computer the image information and the information outputting program, are stored in the recording medium (paragraph 14/paragraph 17);

Kiso does not explicitly disclose the image information includes plural processed image information having different resolutions. However, when saving image files, it is common to save pictures of different resolutions. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include plural processed image information having different resolutions in Kiso. One

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would have been motivated to include plural processed image information having different resolutions in order to support a wide range of picture formats.

Claim 7: Kiso discloses a storage medium as in Claim 6 above, further comprising:

a. the plural processed image information is at least screen data for display in a display device (paragraph 6).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar Abdul-Ali whose telephone number is 571-270-1694. The examiner can normally be reached on Mon-Fri(Alternate Fridays Off) 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571-270-1065. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OAA
05/14/2007



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